Supreme Court, U.S.
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No. 99-1996

IN THE

Supreme Court of the United States

J.E.M. AG SUPPLY, INC. (doing business as Farm Advantage, Inc.) FARM ADVANTAGE, INC., LARRY BENZ, MERLE PRUETT (doing business as Siouxland Seeds, Inc.), KEVIN WOLFSWINKEL, TIM KAMSTRA and TOM EISCHEN SEED & CHEMICALS,

Petitioners,

v.

PIONEER HI-BRED INTERNATIONAL, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether utility patents relating to plants developed by human intervention are proper statutory subject matter under 35 U.S.C. § 101?

STATEMENT PURSUANT TO RULE 29.6

Respondent, Pioneer Hi-Bred International Inc., is a wholly owned subsidiary of E.I. du Pont de Nemours and Company.

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STATEMENT OF THE CASE

On February 20, 1998, Respondent Pioneer Hi-Bred International, Inc. ("Pioneer") brought a patent infringement suit against Petitioners (collectively "Farm Advantage") for infringement of seventeen utility patents. Each of the utility patents allegedly infringed have claims directed to corn hybrids developed by Pioneer that were sexually produced. The patented plant inventions are embodied in various corn hybrids sold throughout the United States by Pioneer.

Farm Advantage is a reseller (purchase and then sell to customers) of many products. Pioneer alleges that Farm Advantage resold Pioneer-brand seed corn in violation of a limited label license contained on each bag of seed. Farm Advantage filed a motion for summary judgment on March 30, 1998 seeking to invalidate all of the claims of all of the patents-in-suit on the sole basis that the inventions did not fall within the classes of permissible statutory subject matter protected by 35 U.S.C. § 101.

The trial court, after oral argument from the parties and consideration of all the evidence, denied Farm Advantage's Motion for Summary Judgment. The pertinent portion of that ruling reads as follows:

> [T]his Court is persuaded that it must find that the Plant Variety Protection Act is not the sole and exclusive method of protecting seed corn. It boils down to the fact that it is Congress' job to answer this question. At no place in any of the statutes does it say that seed corn plants cannot be given a patent. At no place in the statutes does it say that you cannot have both patent and PVPA

> protection. At no place in the law does it say that you have to make an election of one or the other, section 101 or the P.V.P.A.

(App. 39).

Senior Judge Donald E. O'Brien, in drafting his order, carefully reviewed the legislative histories, as well as the case law surrounding the interpretation of 35 U.S.C. § 101, including *Diamond v. Chakrabarty*, 447 U.S. 303, 100 S. Ct. 2204, 65 L. Ed. 2d 144 (1980). The district court stated:

> This Court finds no explicit support in the legislative history for the premise, advanced by the defendants', or an intent to restrict or limit the scope of patentable subject matter available pursuant to 35 U.S.C. § 101. Congress's intention in adopting the PPA and PVPA was to extend patent protection to an area not often able to meet the requirements of 35 U.S.C. § 112, given the then limits of plant science. History demonstrates, however, that in those instances where inventors showed they could define a reproducible plant meeting the limits of § 112, plant patents were issued under § 101. An early example of this is the Boehm patent, U.S. Patent 2,048,056 (1936) (Plaintiff's Exhibit D). Today, the requirements of § 112 can be met through a written description combined with a deposit of the invention as required for some microorganisms. Manual of Patent Examining Procedure § 2403.02 (6th ed. 1997). In passing the PVPA and PPA, Congress maintained the broad language of § 101 in order to recognize, reward, and encourage

> developments in plant breeding that were capable of someday meeting the enablement requirements. *See Chakrabarty*, 447 U.S. at 312-315.

(App. 29-30). In ruling on this matter, the district court reaffirmed the broad interpretation that has been accorded section 101 by the Supreme Court.

Due to the fact that continued vitality of the Patent Act depends greatly on the expansive scope of section 101 and its ability to encompass those innovations which cannot now be anticipated, this broad interpretation consistent with prior Supreme Court precedent was affirmed by the Federal Circuit. As noted by the Federal Circuit:

> In *Chakrabarty*, the [Supreme] Court dealt directly with this provision, responding to the arguments concerning the patentability of Dr. Chakrabarty's new bacterium that was engineered to consume oil spills. The [Supreme] Court explained that the patent system is directed to the inventive works of mankind, and is not otherwise limited: "In choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope." 447 U.S. at 308, 100 S.Ct. 2204, 65 L.Ed.2d 144, 206 U.S.P.Q. at 197.

Pioneer Hi-Bred International, Inc. v. J.E.M. Ag Supply, Inc., 200 F.3d 1374, 1376 (Fed. Cir. 2000). The Circuit Court concluded:

> The Court in *Chakrabarty* responded to the objection to patenting living things by stating that

"Congress is free to amend § 101 so as to exclude from patent protection organisms produced by genetic engineering. . . . Or it may choose to craft a statute specifically designed for such living things." 447 U.S. at 318, 100 S.Ct. 2204, 65 L.Ed.2d 144, 206 U.S.P.Q. at 201. The defendants argue that this is what Congress did in the PVPA. However, the PVPA does not purport to remove plants from the patent statute. Neither Congress nor the courts excluded new plant varieties from the patent statute; the enactment of the PVPA did not effect such an exclusion.

The defendants also object that Pioneer has obtained patents under Title 35 as well as certificates under the PVPA, and state that these statutes are in conflict. The district court observed, correctly, that the asserted conflict is simply the difference in the rights and obligations imposed by the two statutes. It is not unusual for more than one statute to apply to a legal or property interest. For example, an ornamental design may qualify for protection under both copyright and design patent law. The fact that laws are of different scope does not invalidate the laws.

Pioneer Hi-Bred, 200 F.3d at 1378. Because these issues have already been decided by this Court in *Chakrabarty*, Petitioners' request for a writ for certiorari should be denied.

REASONS FOR DENYING THE WRIT

This Court's decision in *Diamond v. Chakrabarty*, 447 U.S. 303, 100 S. Ct. 2204, 65 L. Ed. 2d 144 (1980), ("Chakrabarty") directly addresses the question in this case. The arguments made by Petitioners are nothing more than arguments already rejected by the District Court and the Federal Circuit Court of Appeals in light of this well-established precedent. The Federal Circuit, created to eliminate inconsistencies in patent matters and thereby eliminating any possibility of intercircuit conflict, correctly applied *Chakrabarty* and concluded that there was no exclusion for living matter, which include plants, expressly or impliedly found in 35 U.S.C. § 101. Therefore, Petitioners' request for a writ of certiorari should be denied as not being in conflict with any Supreme Court decision.

I.

THE FEDERAL CIRCUIT DECISION IS CONSISTENT WITH THE SUPREME COURT'S LONG-STANDING DECISION OF *DIAMOND v. CHAKRABARTY*

The issue in this appeal, as was in this Court's decision in *Chakrabarty*, is one of statutory construction of the categories of patentable subject matter included within 35 U.S.C. § 101. Specifically, both the District Court and the Federal Circuit held consistent with *Chakrabarty* that inventions relating to plants are capable of utility patent protection.[1] While such matter might also qualify for

1. Although sometimes used interchangeably by Petitioners, utility patents (including utility patents on plants) are those protected under 35 U.S.C. § 101, while plant patents are governed by 35 U.S.C. § 161, *et seq.* There is no requirement in these statutes that only one form of protection must be elected or is available.

protection under the Plant Variety Protection Act, there is no support for the argument that such protection is mutually exclusive.

A. This Court in *Chakrabarty* Established That Living Matter Falls Within the Protection of 35 U.S.C. § 101

Section 101 provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

As this Court already recognized in *Diamond v. Chakrabarty*: "In choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope." *Diamond v. Chakrabarty*, 447 U.S. at 308, 100 S. Ct. at 2207. Petitioners, however, seek to narrowly construe *Chakrabarty* as a case limited to the factual determination of bacteria only as patentable subject matter. Petitioners opine that although bacteria is included in 35 U.S.C. § 101, plants cannot be protected because of the passage of the Plant Patent Act ("PPA") of 1930 and the Plant Variety Protection Act ("PVPA") of 1970. This argument is made in spite of the clear and broad language in *Chakrabarty* that "living things" (which of course includes plants) are potentially patentable subject matter under section 101. The Supreme Court's decision was based on analysis of the same legislative history now relied on by Petitioners, and the same arguments were then soundly rejected and should be now.

Similar to Petitioners' position here, the government urged in *Chakrabarty* that section 101 of Title 35 did not include coverage for living things, arguing that if that section did protect living organisms, then those subsequent acts (the 1930 PPA and the 1970 PVPA) concerning living plant material would have not been necessary.

This Court rejected those arguments, and found that the passage of the 1930 PPA and 1970 PVPA did not support the position that section 101 did not include living things. The Court in *Chakrabarty* understood extremely well what necessitated the passage of both the 1930 Plant Patent Act and the 1970 Plant Variety Protection Act. As noted in the opinion delivered by Chief Justice Burger:

> Prior to 1930, two factors were thought to remove plants from patent protection. The first was the belief that plants, even those artificially bred, were products of nature for purposes of the Patent Law. . . . The second obstacle to patent protection for plants was the fact that plants were thought not amendable to the "written description" requirement of the Patent Law. . . . In enacting the Plant Patent Act, Congress addressed both of these concerns. . . . Nor does the passage of the 1970 Plant Variety Protection Act support the government's position. As the government acknowledges, sexually reproduced plants were not included under the 1930 Act because new varieties could not be reproduced true-to-type through seedlings. . . . By 1970, however, it was generally recognized that true-to-type reproduction was possible and that plant patent protection was therefore appropriate. The 1970

> Act extended that protection. There is nothing in its language or history to suggest that it was enacted because § 101 did not include living things.

Id., 447 U.S. at 311-313, 100 S. Ct. at 2209-2210.

In spite of the clear language stating that the PPA and PVPA were passed due to scientific, and not legislative, constraints on the Patent Act, Petitioners are attempting to make the same arguments decided adversely to its position in *Chakrabarty*. However, instead of arguing that section 101 excludes living things in their entirety, Petitioners argue that those plant-related acts resulted in the exclusion of plants themselves from section 101, and that such acts would not have been necessary if plants were included in the general subject matter of section 101. Again, this position is contrary to the prior decision in *Chakrabarty*, as the lower Courts correctly found.

B. Petitioners' Use of Legislative History Comments During the Passage of Other Acts is Improper and Unavailing

In *Chakrabarty*, this Court was critical of the use of statutory history of a later Congress to construe the scope of patentable subject matter enacted by an earlier legislative action. *Chakrabarty*, 447 U.S. at 312-13, 100 S. Ct. at 2209. Petitioners are guilty of similar attempts in this case. Instead of construing section 101 based on its' own statutory history, Petitioners resort to the statutory history of two unrelated acts, the Plant Patent Act (1930) and the Plant Variety Protection Act (1970).

As noted previously by the Federal Circuit, citing to this Court: "Simply because a later enacted statute affects in some way an earlier enacted statute is a poor reason to ask [a court] . . . to re-write the earlier statute. Repeals by implication are not favored." *Roche Products, Inc. v. Bolar Pharmaceutical Co.*, 733 F.2d 858, 864 (Fed. Cir. 1984). Thus, "courts are not at liberty to pick and choose among congressional enactments, and when two statutes are capable of coexistence, it is the duty of courts, absent a clearly expressed congressional intention to the contrary, to regard each as effective." *Morton v. Mancari*, 417 U.S. 535, 551, 94 S. Ct. 2474, 2483, 41 L. Ed. 2d 290 (1974).

The Patent Act, Plant Patent Act and Plant Variety Protection Act not only coexist, but have coexisted for the past 30 years. Surely Congress knows this and could have enacted an express exclusion if it wished. As noted by the District Court, the Patent Statutes in the Plant Variety Protection Act have been amended at least 18 times since 1980 and Congress has not grafted any specific limitation limiting the interpretation of section 101 in light of *Chakrabarty*. Since *In re Hibberd*, 227 U.S.P.Q. 443 (Bd. Pat. App. & Interf. 1985), the Patent Office has been allowing plant-related utility patents subject to the stringent patentability requirements demanded of all 35 U.S.C. § 101 inventions. In fact, as also noted by the District Court, if this practice was contrary to the views of Congress, they have had ample time since the *Hibberd* decision in 1985 to correct this practice, and have not done so.

Although they argue that the Plant Patent Act and Plant Variety Protection Act evidence the intent of Congress to exclude plants from the subject matter of section 101, Petitioners ignore the fact that neither of these acts protects

plants per se. Both of these acts protect distinct and separate categories into which the vast majority of plants do not fall. The Plant Patent Act protects only those discoveries relating to a asexually reproduced plants. 35 U.S.C. § 161. The Plant Variety Protection Act protects only novel varieties of sexually reproduced plants. 7 U.S.C. § 2402(a). If Congress had intended to carve out plants from section 101, it most certainly would not have limited this later enacted method of protection to only those two limited categories of plant material!

The statutory history of section 101 is clear. The broad language at issue here, "manufacture" and "composition of matter", is essentially unchanged from the original patent act. Congress, recognizing a gap, not in protection but in application (35 U.S.C. § 112), drafted the 1930 Plant Patent Act. That Act did not exclude anything from section 101, but instead created an entirely new form of protection which was set forth in section 161 of Title 35 for asexually produced plants. Again, section 101 remained substantially unchanged. As stated by the Supreme Court above, the passage of the 1970 Plant Variety Protection merely provided an extension of the protection concept of the 1930 Plant Patent Act to certain other types of plants. Section 101, remaining substantially unchanged to this day, continues to protect "anything under the sun that is made by man." See most recently *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1093, 119 S. Ct. 851, 142 L. Ed. 2d 704 (1999).

C. The Supreme Court Has Consistently Held That Two or More Legal Protections Can Be Available

In *Chakrabarty*, this Court interpreted the scope of 35 U.S.C. § 101 as including coverage for living things, such as microorganisms. Petitioners attempt to read into the *Chakrabarty* decision an exclusion for plants. No such exclusion can be supported. *Chakrabarty* stands for the proposition that anything under the sun that is made by man, including living organisms, can be covered under the provisions of section 101.

Petitioners have shown only that the scope of protection available under section 101 is different than the scope of protection under the Plant Patent Act or the Plant Variety Protection Act. These acts do not protect the same matter in similar ways. There is ample precedent, including decisions from the Supreme Court, that the availability of one form of statutory protection does not in and of itself preclude the availability of protection under another form. *See, e.g., Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 485-87, 94 S. Ct. 1879, 1888-89 (1974) (holding that trade secret and patent protection can peacefully coexist); *Mazer v. Stein*, 347 U.S. 201, 217, 74 S. Ct. 460, 470 (1954) (holding that patentability of a manufactured article does not bar copyright as a work of art). Both the district court and the Federal Court correctly cited this well-established law in reaching their legal conclusions.

Petitioners cite the case of *Kepner v. United States*, 195 U.S. 100, 125 (1904) for the proposition that the lower Courts' position somehow contravenes the legislative interpretation premise that a specific statute must overrule a more general statute. However, the Plant Patent Act is no

more specific or generalized than the Patent Act as codified in section 101. Neither section 161 of the Plant Patent Act, nor the specific provisions of the Plant Variety Protection Act, overrule or are incompatible with the provisions of the Utility Patent Statutes codified at 35 U.S.C. § 101. These Acts are simply differing types of statutory protection. Just as the design patent statutes (35 U.S.C. § 171) do not preempt the utility patent statutes, neither do the Plant Patent Act or the P.V.P.A. preempt 35 U.S.C. § 101.

Lastly, petitions cite the recent FDA tobacco case in support of its application for a writ. Not only does the *Brown & Williamson* case not address the situation of multiple statutory protection schemes found throughout intellectual property law, it is completely inapplicable to the present issue because of the express intent of section 101 to cover "anything made under the sun by man."

CONCLUSION

For the foregoing reasons, Petitioners' request for certiorari should be denied. Both the district court and the Federal Circuit correctly applied the *Chakrabarty* decision which holds that "anything made under the sun by man is patentable subject matter." *Chakrabarty*, 447 U.S. at 309, 100 S. Ct. at 2207-08.

As discussed in *Chakrabarty*, the application of the patent statute (35 U.S.C. § 101) is intended to be broad. Very rare is the occurrence where Congress has restricted the application of section 101. When Congress has taken such drastic action, it has done so expressly and with good reason. *See* 42 U.S.C. § 2181 (excludes atomic weapons inventions).

The decision from which certiorari is sought represents routine application of settled law, and meets none of the established criteria for being worthy of a Writ of Certiorari.

Respectfully submitted,

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